



JPW

500.42889X00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): R. TSUCHIYAMA, et al
Serial No.: 10/602,603
Filed: June 25, 2003
For: MAGNETIC HEAD SLIDER AND MAGNETIC DISK UNIT
Group: 2652
Examiner: T. Chen

RESPONSE

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

November 22, 2004

Sir: -

In response to the Office Action dated October 20, 2004, the following remarks are respectfully submitted in connection with the above-identified application.

The requirement for restriction to one of the inventions identified as invention I - claims 1-6, drawn to a magnetic head slider, classified in class 360, subclass 235.8 and invention II - claims 7 and 8, drawn to a magnetic disc unit, classified in class 360, subclass 97.01, is traversed as being improper, and reconsideration and withdrawal of the restriction requirement are respectfully requested.

The Examiner indicates that inventions II and I and are related as combination and subcombination with the Examiner referring to the requirements of MPEP §806.05(c) for showing distinctness if at least it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability. Applicants note that the features of at least claims 1 and 2 of invention I, related to the subcombination, are substantially found in independent

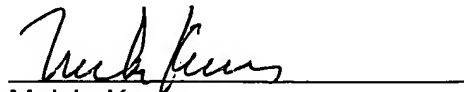
claim 7 of invention II, such that the Examiner's position that the combination as claimed does not require the particulars of the subcombination as claimed is clearly erroneous. While the Examiner refers to features of dependent claim 3 of invention I as not being found in the claims of invention II, applicants submit that the Examiner cannot ignore the features of independent claim 1 and dependent claim 2 of invention I related to the subcombination which are found in independent claim 7 of invention II related to the combination. Thus, applicants submit that the combination of claim 7 of invention II, as claimed, relies on the features of the subcombination, as claimed, as represented by claims 1 and 2 of invention I for patentability, and the Examiner has failed to properly show distinctness in accordance with the requirements of MPEP §806.05(c). Likewise, applicants submit that the additional requirement concerning showing of utility also has not been properly shown. For the foregoing reasons, applicants submit that the restriction requirement is improper and should be withdrawn.

In order to provide a complete response to the restriction requirement, applicants provisionally elect, with traverse, invention I including claims 1-6.

For the foregoing reasons, applicants request withdrawal of the restriction requirement and favorable action with respect to all claims present in this application.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (500.42889X00) and please credit any excess fees to such deposit account.

Respectfully submitted,



Melvin Kraus

Registration No. 22,466

ANTONELLI, TERRY, STOUT & KRAUS, LLP

MK/cee
(703) 312-6600